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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,091	02/23/2004	Kurt Hamilton	HAMMI.10040	6895
38715 7590 02/14/2007 JEROME V. SARTAIN MIND LAW FIRM 2424 S.E. BRISTOL STREET SUITE 300 NEWPORT BEACH, CA 92660			EXAMINER LAUX, JESSICA L	
			ART UNIT 3635	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS		MAIL DATE 02/14/2007	DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/784,091	Applicant(s) HAMILTON, KURT	
	Examiner Jessica Laux	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/02/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment is made of the amendment filed 12/02/2006.

Response to Arguments

Applicant's arguments filed 12/02/2006 have been fully considered but they are not persuasive.

Applicant argues that the use of the closed phrase "consisting essentially of" limits the claim to only parts or steps recited and that anything not recited is not part of the claimed invention and thus the joint construction and methods of the prior art that include the use of joint cement at the center-line surface is precluded. However, examiner notes that the claim further recites "a joint finishing system... including a flexible layer" and no other structure or limitation is included in the joint finishing system. The phrase "joint finishing system" itself provides no structure or limitations and therefore any prior art having a joint finishing system that includes a flexible layer anticipates the claimed limitations.

Further in regards to claims 1-11 applicant argues that the prior art of record does not disclose a joint finishing system that includes "a flexible layer". Examiner disagrees referencing the previous Office Action rejection where the prior art (figure 5) clearly shows a joint finishing system including a flexible layer, where the flexible layer could be tape 160, which inherently has some flexibility (further applicant discloses in the presently submitted remarks, page 15, line 18, that tape forms a flexible layer).

In regards to claims 12 and 13 applicant argues that the center-line of the joint is formed of a flexible material, tape, rather than any sort of joint compound. Examiner

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notes that in applicant's arguments of claim 13, applicant has merely stated that the claim is not anticipated by the prior without providing any remarks or arguments to support such a claim, and that the argument of the flexible layer being tape and not joint compound is moot and the claims do not recited the limitation of a "flexible layer" and all other claimed features are anticipated by the prior art.

In regards to claims 16 and 17 applicant argues that the claims uses the closed phrase "consisting essentially of..." thereby limiting the claims to only non-tapered drywall boards with a flexible compound (and the associated steps of the method of such a structure), and that the disclosed prior art including tape and joint compound therefore cannot anticipated the claims. Examiner notes in the MPEP 2111.03 [R3] that the use of the phrase 'consisting essentially of' limits the scope of the claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristics" of the claimed invention. Applicant has disclosed, in the specification, drawings and claims, the use of tape and joint compound, therefore, these features being included in the prior art are deemed to 'not materially affect the basic and novel characteristics of the claimed invention'. Accordingly the prior are anticipates the claims as presented in the previous office action.

In regards to claims 18-19 applicant argues that the prior art does not provide for more than one topping coat to be applied however, the rejection of the previous Office Action cited applicant's figure 5 (admitted prior art), which only provides one topping coat, therefore applicant's arguments are moot.

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In regards to claims 4 and 11 applicant argues that USG does not disclose the claimed method and use of the non-shrinking joint compound. Examiner notes that The USG reference is not relied upon for its disclosure of the use and method but rather merely for the teaching of a non-shrinking joint compound. The disclosure of the USG reference does not preclude the non-shrinking joint compound to be used in the claimed manner. As the prior art compound and applicant's disclosed and claimed compound are structurally equivalent the prior art compound is clearly capable of being used in the claimed manner.

Accordingly applicant's arguments are not persuasive and the claims stand rejected as presented below.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by applicant admitted prior art Figure 5 and as disclosed in the specification on pages 12 and 13.

Regarding claims 1-3, 5-10 and 12-16 and 17-19: Applicant admitted prior art discloses a drywall joint construction (Figure 5) consisting essentially of: a first drywall board (120) having a first lengthwise edge and an outwardly-facing first planar surface; a second drywall board (130) having a second lengthwise edge and an outwardly-facing second planar surface, the second drywall board being positioned adjacent the first

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drywall board such that the first and second lengthwise edges are brought into substantially abutting contact so as to form a lengthwise crack between the first and second planar surfaces (Figure 5), a center-line surface of the joint construction being defined as the outwardly-facing surface directly over the crack and exposed for surface treatment; and a joint finishing system installed within the crack to complete the drywall joint construction, the system including a flexible layer forming the center-line surface (Specification page 12, line 28- page 13, line3). Wherein the first lengthwise edge is tapered inwardly, yet substantially perpendicular, from the first planar surface and the second lengthwise edge is tapered inwardly, yet substantially perpendicular, from the second planar surface (Figure 5) such that the crack is configured as an outwardly-opening channel/slit having opposite angled channel sides (Specification page 12, lines 27-29); and the joint finishing system comprises: a taping compound (152), comprising a joint cement (where applicant admits on page 3 of the specification, lines 8-9, that a first coat of conventional joint cement compound is applied to the recess in the drywall joint, and where joint compound is a flexible compound), filling the channel so as to cover the channel sides (Figure 5 and Specification page 12, lines 28-29); and a tape (160), having first and second marginal edges (Figure 5), forming the flexible layer and covering the taping compound so as to flush the joint finishing system with the first and second planar surfaces (Figure 5). A skim coat is applied over the tape and beyond the marginal edges so as to blend the tape with the first and second planar surfaces (Figure 5).

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Claims 1-4, 5-10 and 12-19 are rejected under 35 U.S.C. 102(a) as being anticipated by My Great Home®.

Regarding claims 1-4, 5-10, and 12-19: My Great Home discloses a drywall joint construction consisting essentially of: a first drywall board having a first lengthwise edge and an outwardly-facing first planar surface; a second drywall board having a second lengthwise edge and an outwardly-facing second planar surface, the second drywall board being positioned adjacent the first drywall board such that the first and second lengthwise edges are brought into substantially abutting contact so as to form a lengthwise crack between the first and second planar surfaces, a center-line surface of the joint construction being defined as the outwardly-facing surface directly over the crack and exposed for surface treatment (steps 3-7); and a joint finishing system installed within the crack to complete the drywall joint construction, the system including a flexible layer forming the center-line surface. Wherein the first lengthwise edge is tapered inwardly, yet substantially perpendicular, from the first planar surface and the second lengthwise edge is tapered inwardly, yet substantially perpendicular, from the second planar surface such that the crack is configured as an outwardly-opening channel/slit having opposite angled channel sides; and the joint finishing system comprises: a taping compound, comprising a flexible joint cement, filling the channel so as to cover the channel sides; and a tape, having first and second marginal edges, forming the flexible layer and covering the taping compound so as to flush the joint finishing system with the first and second planar surfaces. A skim coat is applied over

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the tape and beyond the marginal edges so as to blend the tape with the first and second planar surfaces (Finishing the drywall steps A and B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant admitted prior art in view of USG.com (sheetrock brand joint compound).

Regarding claims 4 and 10: Applicant disclosed the construction as in the above claims, but did not disclose specifically that the joint compound was of a non-shrinking formulation. The Sheetrock® Brand Durabond™ Joint Compound is known in the art and is of a non-shrinking formulation (Sheetrock® Brand Setting-Type Joint Compounds Submittal Sheet 09250, Copyright 2001). Therefore it would have been obvious at the time the invention was made to modify the admitted prior art to have a joint cement of a non-shrinking formulation as disclosed by Sheetrock® Brand Durabond™ Joint Compound as such a modification would provide the advantage of a stronger more long lasting joint.

Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over My Great Home® in view of USG.com (sheetrock brand joint compound).

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Regarding claims 4 and 10: My Great Home® disclosed the construction as in the above claims, but did not disclose specifically that the joint compound was of a non-shrinking formulation. The Sheetrock® Brand Durabond™ Joint Compound is known in the art and is of a non-shrinking formulation (Sheetrock® Brand Setting-Type Joint Compounds Submittal Sheet 09250, Copyright 2001). Therefore it would have been obvious at the time the invention was made to modify the admitted prior art to have a joint cement of a non-shrinking formulation as disclosed by Sheetrock® Brand Durabond™ Joint Compound as such a modification would provide the advantage of a stronger more long lasting joint.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 6:30am to 2:30pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

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02/02/2007


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